

REMARKS

In accordance with the foregoing, claims 5, 10, and 12 are amended. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

Claims 5-8, 10, and 12 are pending and under consideration.

Items 4-5: Rejection Of Claims 5-8, 10 and 12 under 35 U.S.C. §112, second paragraph

In items 4-5 of the Office Action, the Examiner rejects independent claims 5, 10, and 12 (and dependent claims 6-8) under 35 U.S.C. §112, second paragraph, as being indefinite. (Action at pages 2-3). The Examiner asserts:

[E]xemplary claim 5 recites: "wherein the request data for insurance includes produce data specified by a user terminal from *purchase data stored in said first computer storage...*" It is unclear to the Examiner how the phrase "from purchase data stored in said first computer storage" is intended to modify the current claim.

(Action at page 3).

Claim 5 is amended herein to recite a system including:

an insurance request part which sends request data for insurance on at least one product to the insurer terminal, wherein the request data for insurance includes first data on the at least one product, which is specified by a user terminal based on the purchase information stored in said first computer storage, and second data on the at least one product, which is based on the information from the manufacturer stored in said second computer storage.

(Amendatory language being underlined)

That is, as amended herein, using claim 5, as an example, the recited "purchase information related to products" is stored and "first data" is data on at least one product, "which is specified by a user terminal based on the purchase information based on the purchase information stored (emphasis added)." That is, the first data is not per se (all) purchase information related to (all) products of the user. Independent claims 10 and 12 are amended herein in a similar manner.

Applicant submits that claims 5-8, 10 and 12 are definite and comply with 35 U.S.C. §112, second paragraph, and request the rejection be withdrawn.

Item 7: Rejection of claims 5-6, 10, and 12 under 35 U.S.C. §103(a) as being unpatentable over Joao (U.S.P. 6,347,302) in view of Thomson et al (U.S.P. 200310061104)

Item 8: Rejection of claim 7 under 35 U.S.C. §103(a) as being unpatentable over Joao in view of Thomson and McMillan et al (U.S.P. 5,797,134)

Item 9: Rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Joao and in view of Thomson and Lockwood (U.S.P. 4, 567,359)

In item 7 of the Office Action, the Examiner rejects independent claims 5, 10, and 12 (and

dependent claim 6) under 35 U.S.C. §103(a) as being unpatentable over Joao in view of Thomson. (Action at pages 3-8). In item 8 of the Office Action, the Examiner rejects dependent claim 7 under 35 U.S.C. §103(a) as being unpatentable over Joao in view of Thomson and McMillan. (Action at page 8). In item 9 of the Office Action, the Examiner rejects dependent claim 8 under 35 U.S.C. 103(a) as being unpatentable over Joao and Thomson and in view of Lockwood. (Action at page 9).

The rejections are traversed. As set forth in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."

Applicant submits that the none of the cited art, alone or in combination, recite all recited features of each independent claim.

The Action concedes:

Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured.

(Action at page 4, lines 5-7).

However, in an attempt to establish *prima facie* obviousness, the Examiner contends:

it would have been obvious to modify the system of Joao with the teaching of Thomson to include a user, the manufacturer, and insurer, and to have information provided supplemented by the necessary parties as needed. As suggested by Thomson, one would have been motivated to include these features to so that the manufacturer gains valuable information about the long term satisfaction of customer and to allow the customer to gain important product information regarding recalls, thereby promoting brand loyalty. (Thomson, abstract)

(Action at page 7, lines 11-18).

Applicants submit that *prima facie* obviousness is not established, at least, since the reference, i.e., Thompson, which the Examiner is relying on in support of the rejection to establish *prima facie* obviousness, is not available as a reference in support of the rejection.

Applicants point out to the Examiner that Thompson is now abandoned. A copy of the USPTO PAIR is attached for the convenience of the Examiner. (Attachment 1).

As set forth in MPEP 2127:

An abandoned patent application may become evidence of prior art only when it has been appropriately disclosed, as, for example, when the abandoned patent [application] is reference[d] in the disclosure of another patent, in a publication, or by voluntary disclosure under [former Defensive Publication rule] 37 CFR 1.139.

That is, Thomson was only available in support of a §103 rejection as of the Publication

date of March 27, 2003, which is after the filing date of the present application of February 21, 2001.

Applicant also points out that Thomson was a Continuation-in-part of Application no. 09/526,353 filed on March 16, 2000 (also abandoned).

As set forth in MPEP §706.02 entitled Rejection on Prior Art, the effective filing date of a continuation-in-part application is the filing date of the application, i.e., March 14, 2001 except for "claims which are fully supported under 35 U.S.C. §112 by the earlier parent application have the effective filing date of that earlier parent application."

Further, as further set forth, by MPEP §2142 "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."

Applicant submits that the Examiner has not factually supported that the claims in Thompson were fully supported by the earlier parent application.

Applicant also points out that Application no. 09/526,353 was never published, as shown in the attached copy of the PAIR printout, and thus is *arguendo* unavailable as a reference in support of the current rejection. (Attachment 2)

In addition, Applicant submits there is no motivation to *arguendo* modify Jao's method for processing "lease" insurance information with a means to contact the customer about other products, product recalls and affinity programs thereby promoting brand loyalty, as the Examiner contends.

Summary

Since features recited by each of the independent claims 5, 10, and 12 (and dependent claims 6-8) are not recited by an *arguendo* combination of the art available in support of the rejection and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 5-8, 10, and 12.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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